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THE TTAB

Paper No. 10

HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sonnet Technologies, Inc.

Serial No. 75/600,235

Howard J. Klein of Klein & Szekeres, LLP for
Sonnet Technologies, Inc.

Tracy Cross, Trademark Examining Attorney, Law Office 103
(Dan Vavonese, Acting Managing Attorney).

Before Cissel, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Sonnet Technologies, Inc. has filed an application to
register the mark SONNET and design, as shown below, for
"computer hardware."¹

¹ Serial No. 75/600,235, filed December 7, 1998, claiming a date
of first use and first use in commerce of May 1992.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark SONNET, which is registered for "computer software for analyzing electronic circuits."² The refusal has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we are guided by the well-established principle that although the marks must be considered in their entirety, there is nothing

² Registration No. 2,017,720, issued November 19, 1996, setting forth a first use date of 1983 and a first use date in commerce of 1984.

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). It is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods and thus it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

Here the word portions of the marks are the same, the single word SONNET. The marks are identical in sound and connotation. Furthermore, the word SONNET would appear to be arbitrary as used with the computer software of registrant, as well as the computer hardware of applicant.

Although applicant points to the design elements of its mark as a distinguishing feature, we do not consider these features so distinctive that purchasers would be likely to rely upon and refer to applicant's goods in terms of the design, rather than the word SONNET. Furthermore, since registrant has elected to register its mark in typed drawing form, registrant is free to use the mark in any form it chooses, including one very similar to the form in

which applicant seeks to register the word. As stated in *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991), where the mark was registered in typed form:

... the display of a word mark may be changed at any time at the whim of its owner; rights in such a mark reside in the term itself rather than in any particular form thereof. (Cite omitted)).

Inasmuch as registrant is free to adopt any design for its mark, applicant's reliance upon cases involving marks each having a specific design feature is misplaced. Any argument with respect to difference in type style or design is not viable when, as here, the registrant has not restricted its rights to a particular display. See *Squirto Co. v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983).

Accordingly, we find the overall commercial impressions created by applicant's SONNET and design mark and registrant's SONNET mark to be highly similar.

Turning to the goods involved, we note that as a general principle, the issue of likelihood of confusion must be determined on the basis of the goods as identified in the application and in the cited registration(s). *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed.Cir. 1987). If there are no restrictions in the application or registration(s) as to

channels of trade, the parties' goods must be assumed to travel in all the normal channels of trade for goods of this nature. See Kangol Ltd. v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Moreover, it is not necessary that the goods of the applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective goods are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate, or are associated with, the same source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

The goods of both applicant and registrant are identified in very broad terms in the application and registration. Applicant's "computer hardware" is totally unrestricted as to types of hardware components, fields of use, or channels of trade in which the hardware is offered. Registrant's software, while restricted to a particular function, is similarly unlimited as to channels of trade or fields of use. Accordingly, we find the web pages made of record by the Examining Attorney fully adequate to

demonstrate that, since the same entities, such as the AppleStore or CompUSA, offer both hardware and software, both hardware of the type identified in the application and software of the type identified in the registration travel in the same channels of trade and are offered by the same entities to the same potential customers.

Moreover, although applicant argues that registrant's software is highly specialized applications software, applicant had failed to make any evidence of record to substantiate that registrant's software, as identified in the registration, should be so construed.⁴ Instead, we must concur with the Examining Attorney that because registrant's software is broadly described as being used for analyzing electronic circuits and because applicant's hardware necessarily has electronic circuits, registrant's software might well be used in conjunction with applicant's hardware.

We fully agree with applicant that there is no "per se" rule in the field of computer products whereby all

⁴ The Examining Attorney has properly objected to the declaration of Robert Farnsworth, which is attached to applicant's brief, as being untimely. See Trademark Rule 2.142(d). Accordingly, we have given the declaration no consideration. We deny applicant's request that the application be remanded to the Examining Attorney for consideration of the declaration at this point in time; applicant had ample opportunity to file such a declaration earlier in the prosecution.

computer hardware and software products are considered related. See *In re Quadram Corp.*, 228 USPQ 863 (TTAB 1985). In the *Quadram* case, however, insufficient overlap was found between a "specific, specialized piece of peripheral computer hardware" and a "specific, specialized type of applications software" to warrant a holding of likelihood of confusion. A distinction was drawn between applications software designed for a particular application and other types of "utility" or "systems" software which help a computer or its peripherals operate in general.

Here, we have no reason to make such a distinction. Instead, registrant's software must be viewed as "utility" software, in that it may be used to analyze the electronic circuits of computer hardware. In view of the broad way the goods are identified, we can only conclude that a complementary relationship exists between the hardware of applicant and the software of registrant. There is a much more direct tie-in between the software and hardware involved here than the mere fact that both products are linked in some way to the use of computers or that both may be categorized as being computer hardware and/or software. Cf. *Information Resources Inc. v. X*Press Information Services*, 6 USPQ 1034 (TTAB 1988)(marked differences between opposer's specialized information analysis software

and applicant's service of transmitting news and general information to computers via satellite and cable television lines); Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992)(insufficient relationship found between opposer's computer data processing programming/information management services and applicant's computer software programs for electrical distribution system analysis and design.)

Thus, because the goods of both applicant and registrant must be presumed to travel in the same channels of trade and to be encountered by the same persons, we find the relationship between the goods sufficient, that if the respective SONNET marks are used thereon, potential purchasers might well assume a common origin for the goods.

The only remaining factor raised by applicant is the lack of evidence of actual confusion, despite the concurrent use of the marks since 1992. We simply note that this factor can be given little weight in an ex parte proceeding. Whether or not we gave any consideration to the declaration untimely submitted by applicant, with respect to applicant being unaware of any instances of confusion, we still have had no opportunity to hear from registrant on this point. In addition, we have no information as to the geographic overlap of markets and,

thus, the actual potential for confusion. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Accordingly, on the basis of the similarity of overall commercial impressions created by applicant's SONNET and design mark and registrant's SONNET mark and the relationship between the computer hardware of applicant and the computer software for analyzing electronic circuits of registrant, we find a likelihood of confusion with concurrent use of the marks. To the extent that there may be any remaining doubt, we follow the well-established principle that any doubt regarding likelihood of confusion must be resolved against applicant as the newcomer in the field. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.